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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,287

08/08/2005

Manabu Sutoh

71,051-001

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27305

7590

08/04/2008

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,287	<b>Applicant(s)</b> SUTOH ET AL.	
	<b>Examiner</b> ROBERT LOEWE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's arguments/remarks, filed on 6/18/08 have been fully acknowledged.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Romenesko (US Pat. 4,163,082).

Romenesko teaches a UV-curable organopolysiloxane liquid which is coated onto a silicone gel or grease, said silicone gel or grease is adhered to a substrate (abstract). Romenesko teaches that the silicone gel may be a moderately crosslinked silicone and further teaches that the method of crosslinking may include chemical reaction of silicon-bonded vinyl radicals with silicon-bonded hydrogen radicals (2:60-3:3), which is commonly referred to as hydrosilylation. Romenesko teaches curing the UV-curable organopolysiloxane; therefore, at least one of the silicone layers is cured. Romenesko teaches a substrate having a moderately crosslinked silicone gel coated on the substrate followed by the application of a UV-curable organopolysiloxane liquid, which is then cured. While not explicitly teaching that the silicone gel and UV-curable organopolysiloxane cure at different rates, it is the position of the examiner that the silicone gel and UV-curable organopolysiloxane liquid will have different curing rates.

Claims 1-6 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien et al. (US Pat. 5,932,060).

O'Brien et al. teaches a release laminate comprising a substrate, a first layer comprising a cured silicone composition and a second layer contacting the first layer comprising a silicone pressure sensitive adhesive (3:8-36 and claim 13). The compositional makeup of the first layer comprises (1) an organopolysiloxane having terminal olefinic monovalent hydrocarbon radicals, (2) an organohydrogenpolysiloxane (3) a hydrosilylation catalyst (4:45-5:12). O'Brien et al. further teaches that the first silicone layer may have other components present in the composition, such as fillers and anchorage additives that improve adhesion, i.e., adhesion promoters (6:65-7:3). Therefore, O'Brien et al. teaches the composition of instant claim 4. O'Brien et al. further teaches that the second silicone layer may have additional laminate layers consisting of one or more layers (7:10-15); such layers/films would inherently offer some protection for the second silicone layer. O'Brien et al. teaches that both the first silicone layer and the second silicone layer are cured. The second silicone layer is a silicone pressure sensitive adhesive which comprises a linear silicone polymer with a silicone resin (7:62-64). The silanol groups provide sites for crosslinking between the silicone gum and resin (8:3-12).

While O'Brien et al. does not explicitly teach that either of the silicone layers has a plasticity number which falls within the range of instant claim 2, it is submitted that O'Brien et al. teaches all of the ingredients of instant claim 4. As such, the final physical properties of the first silicone layer would inherently satisfy the limitations of instant claim 2 since a chemical composition and its physical and chemical properties are inseparable. Further, a plasticity range of from 100 to 800 is so broad as to encompass nearly all of the silicone rubbers which serve the role as components in coatings and laminates.

Claim 35: It is the position of the Office that since O'Brien embraces the composition as claimed and further embraces the silicone adhesive sheet of instant claim 1, the silicone rubber layers taught by O'Brien inherently teaches the properties as claimed.

Claims 1-3, 6 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Modic (US Pat. 5,324,542) as evidenced by the incorporation of Modic '542 of either Modic (US Pat. 3,457,214), Modic (US Pat. 3,436,366), or Nelson (US Pat. 3,284,406).

Modic '542 teaches a curable silicone coating composition comprising a vinyl-terminated organopolysiloxane, a silicone resin, a platinum catalyst, an organohydrogenpolysiloxane crosslinker, and a filler (abstract and 7:34-8:11). Modic '542 further teaches that the substrates for the silicone coating composition may be a fiberglass fabric which has coated thereon, a base coating material which may be a silicone layer (10:53-11:27). Modic '214, which is incorporated into Modic '542 teaches that the base coating material may be a condensation curable organopolysiloxane. Modic '366 and Nelson, both incorporated into Modic '542 teach that the base coating material may be an addition curable organopolysiloxane. The final coated composition comprises a fiberglass fabric to which is coated a base layer/first layer of cured organopolysiloxane to which is coated a second layer of a cured organopolysiloxane. It is the position of the Examiner that the compositions taught by Modic '542 inherently have plasticity numbers/Williams plasticity numbers which fall in the range of instant claim 2. A Williams plasticity range of from 100 to 800 is so broad as to encompass nearly all of the silicone rubbers which serve the role as components in coatings and laminates.

Claim 35: It is the position of the Office that since Modic '542 embraces the composition as claimed and further embraces the silicone adhesive sheet of instant claim 1, the silicone rubber layers taught by Modic '542 inherently teaches the properties as claimed.

Claims 1-3, 5, 6 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Suganuma et al. (US Pat. 4,889,576).

Suganuma et al. teaches a silicone rubber adhesive which is used to join silicone-coated fabrics (abstract). The silicone rubber adhesive may be cured via hydrosilylation (abstract). The silicone layer which coats the fabric may also be of the addition-curing type (2:36-42). Any one of the silicone coated layers of the fabric would serve as a protective film for the silicone-based adhesive sheet. Suganuma et al. teaches curing the silicone rubber adhesive (abstract). Suganuma et al. teaches that the Williams plasticity number of the silicone rubber adhesive is from 170 to 600, and explicitly teaches a plasticity of 250 (claim 5 and 6:4), which fully encompasses the range of instant claim 2.

Claim 35: It is the position of the Office that since Suganuma et al. embraces the composition as claimed and further embraces the silicone adhesive sheet of instant claim 1, the silicone rubber layers taught by Suganuma et al. inherently teaches the properties as claimed.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Modic (US Pat. 5,324,542) as evidenced by the incorporation of Modic (US Pat. 3,457,214), Modic (US Pat. 3,436,366), or Nelson (US Pat. 3,284,406) as applied to instant claims 1 and 3 above.

Claim 4: Modic '542 teaches the silicone-based adhesive sheet of instant claim 1, as described above. Modic '542 further teaches that one or both of the silicone layers are curable via hydrosilylation of instant claim 3, as described above. Modic '542 further teaches that the composition comprises ingredients (A), (B), (C) and (E) of instant claim 4 (abstract). Modic '542 does not explicitly teach an adhesion promoter. However, it is the position of the Examiner that adhesion promoters are obvious additives to a person having ordinary skill in the art, especially for silicone compositions which are used in laminated structures, such as those taught by Modic '542. The motivation to add one or more adhesion promoters is simple: to improve adhesion between either the two silicone layers or between the silicone base layer and the substrate.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suganuma et al. (US Pat. 4,889,576).

Claim 4: Suganuma et al. teaches the silicone-based adhesive sheet of instant claim 1, as described above. Suganuma et al. further teaches that one or both of the silicone layers are curable via hydrosilylation of instant claim 3, as described above. Suganuma et al. further teaches that the composition comprises ingredients (A), (B), (C) and (E) of instant claim 4 (3:5-36). Suganuma et al. does not explicitly teach an adhesion promoter. However, it is the position of the Examiner that adhesion promoters are obvious additives to a person having ordinary skill

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in the art, especially for silicone compositions which are used in laminated structures, such as those taught by Suganuma et al.. The motivation to add one or more adhesion promoters is simple: to improve adhesion between either the two silicone layers or between the silicone base layer and the substrate.

### ***Relevant Art Cited***

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6 and 35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications



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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

Examiner, Art Unit 1796

1-Aug-08

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796